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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,282	12/01/2003	Courtney Flem Morgan	CL/V-32784A	1827

31781 7590 01/31/2006
CIBA VISION CORPORATION
PATENT DEPARTMENT
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DULUTH, GA 30097-1556

EXAMINER

COLLINS, DARRYL J

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,282

Applicant(s)

MORGAN ET AL. 

Examiner

Darryl J. Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10, 12, 13, 15 and 17 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-3, 5-10, 12, 13, 15 and 17 is/are allowed.
- 6) ☒ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payor et al (U.S. Patent Number 5,760,870) in view of Tanaka et al (U.S. Patent Number 5,422,687).

Payor et al teaches a contact lens (Figure 10, element 80) having one or more optimized optical zones that accommodate the specific optical variations of the wearer's eye (Figure 10, elements 82 and 84) wherein one or more optical zones are placed within the contact lens in relation to the line of sight of the wearer (column 7, lines 41-47), mechanical features such that the optical zone or zones are positionally maintained while being worn by the wearer (column 5, lines 61-65) as claimed in independent claim 1 and the placement of the optical zones based upon the use in the eye of the user (column 7, lines 41-57) as claimed in dependent claim 5, but fails to teach the placement of the optical zones being determined from the relative measurements of a test lens and the center of the cornea as claimed in dependent claim 2. Tanaka et al, however, does teach a contact lens having multiple optical zones (Figure 1, elements 2 and 4) wherein the contact lens is tailored to the particular eye characteristics of the lens wearer via a offset measurement of the test contact with respect to the center of the eye pupil (column 6, lines 33-60) as claimed in independent claim 1 and further teaches mechanical stabilization means (column 3, lines 27-36)

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as claimed in independent claim 1. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well-known contact optimization techniques as taught by Tanaka et al with the well-known contact lens of Payor et al to achieve a contact lens tailored to the contact lens wearer.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payor et al (U.S. Patent Number 5,760,870) in view of Tanaka et al (U.S. Patent Number 5,422,687) as applied to claims 1, 2 and 5 above, and further in view of Lieberman U.S. Patent Number 6,340,229).

Although Payor et al and Tanaka et al teach or fairly suggest all limitations as claimed in independent claim 1, Payor et al and Tanaka et al fail to teach the use of corneal topography as a technique in the design of the contact lens. Lieberman et al teaches the use of corneal topography as a well-known technique in the design process of a multiple zoned contact lens (column 2, lines 45-49) as claimed in dependent claim 3. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the technique as taught by Lieberman et al to construct the contact lens as taught by Payor et al and Tanaka et al to provide a better fit for the contact wearer.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payor et al (U.S. Patent Number 5,760,870) in view of Tanaka et al (U.S. Patent Number 5,422,687) as applied to claims 1, 2 and 5 above, and further in view of Glady et al (U.S. Patent Number 5,517,260).

Although Payor et al and Tanaka et al teach or fairly suggest all limitations as claimed in independent claim 1, Payor et al and Tanaka et al fail to teach the use of a multi-axis cutting system for creating the claimed contact lens. Glady et al teaches the use of the well-known process of using a multi-axis lathe (column 7, lines 40-48) in the contact lens manufacturing art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well-known technique of contact lens manufacturing as taught by Gladys et al to achieve the multiple zones contact lens as taught by Payor et al and Tanaka et al to achieve a correctly shaped lens.

Claims 7, 9, 10, 12, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al (U.S. Patent Number 5,872,613) in view of Tanaka et al (U.S. Patent Number 5,422,687). Blum et al teaches a method of manufacturing a contact lens having one or more optical zones comprising the steps of obtaining information about the line of sight of the eye (column 2, lines 42-44) and determining the position of the optical zones (column 3, lines 16-30) as claimed in independent claims 7 and 13 and dependent claim 12, but fails to but fails to teach a step wherein the relative measurement of a test lens and the center of the cornea is obtained as claimed in independent claims 7 and 13. Blum et al also teaches a method providing mechanical features to maintain the position of the optical zones with respect to the wearer and to optimize optical zone location (column 3, lines 38-42) as claimed in dependent claim 9 and obtaining information about the line of sight through corneal topography (column 3, lines 21-24) as claimed in dependent claims 10 and 17. Tanaka et al does teach a contact lens having multiple optical zones (Figure 1, elements 2 and 4) wherein the contact lens is tailored to the particular eye characteristics of the lens wearer via a offset measurement of the test contact with respect to the center of the eye pupil (column 6, lines 33-60) as claimed in independent claim 7. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well-known contact optimization techniques as taught by Tanaka et al with the well-

known method of manufacturing contact lenses of Blum et al to achieve a method of providing a well crafted contact lens.

Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum et al (U.S. Patent Number 5,872,613) in view of Tanaka et al (U.S. Patent Number 5,422,687) as applied to independent claim 7 above, in view of Glady et al (U.S. Patent Number 5,517,260). Although Blum et al and Tanaka et al teach or fairly suggest all limitations as claimed in independent claim 7, including the use of a machining technique to produce the contact lens (Blum et al, column 3, lines 43-46), Blum et al and Tanaka et al fail to teach the use of a multi-axis cutting system for creating the claimed contact lens. Glady et al teaches the use of the well-know process of using a multi-axis lathe (column 7, lines 40-48) in the contact lens manufacturing art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well-known technique of contact lens manufacturing as taught by Glady et al in the manufacture of a multiple zones contact lens as taught by Blum et al and Tanaka et al to achieve a correctly shaped lens.

It should also be noted that by the Applicant's own admission, the mechanical features, as claimed in the instant invention, are well known in the art (first paragraph bridging pages 5 and 6 "mechanical features known in the art to keep the contact lens positionally maintained, such as ridges, ballast, and slab-offs").

Response to Arguments

Applicant's arguments filed August 2, 2005 have been fully considered but they are not persuasive. The Applicant's representative has argued that Payor et al (U.S. Patent Number

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5,760,870) and Tanaka et al (U.S. Patent Number 5,422,687), with respect to claims 1, 2 and 5, fail to “disclose or suggest *anything* [emphasis added] about mechanical features to permit centered optical zones of the contact lens to be carried in optimum position by the contact lens for the centered optical zones to remain substantially in line with the true line of sight of the wearer” (see Remarks filed December 27, 2005, page 1, third paragraph). The Applicant’s representative has also argued, with respect to claims 7, 9, 10, 12, 13 and 17, that Blum et al (U.S. Patent Number 5,872,613) fails to disclose or suggest anything about mechanical features to permit centered optical zones of the contact lens to be carried in optimum position by the contact lens for the centered optical zones to remain substantially in line with the true line of sight of the wearer, and that Tanaka et al (U.S. Patent Number 5,422,687) “fails to fill the gap left by the primary reference” (see Remarks filed December 27, 2005, page 2, fourth paragraph). However, Payor et al, at the very least, suggests a mechanical means to stabilize a contact lens and Tanaka et al teaches a mechanical means to stabilize a contact lens as outlined in the rejections above such that, to one of ordinary skill in the art, these well known mechanisms for preventing movement of a contact lens, would have been obvious and are not patentably distinguishable over the prior art.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darryl J. Collins whose telephone number is 571-272-2325. The examiner can normally be reached on 6:30 - 5:00 Monday - Thursday.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



djc



Scott J. Sugarman
Primary Examiner